

REMARKS

Applicant respectfully requests reconsideration of the present application. No new matter has been added to the present application. Claims 1-20 have been rejected in the Office Action. Claims 7 and 10 have been amended herein. No new claims have been added and no claims have been canceled in this Response. Accordingly, claims 1-20 are pending herein. Claims 1-20 are in condition for allowance and such favorable action is respectfully requested.

Informalities

Claim 7 was objected to in the Office Action because it recites “one ore more” instead of “one or more.” Claim 7 has been amended to delete the ‘e’ from “ore.” Applicants submit that the amendment overcomes the objection.

Objections to the Drawings

The Office Action objected to FIG. 1, FIG. 3, FIG. 4, and FIG. 30a. The Office Action objected to FIG. 1 because element 100 is not shown in the drawing and element 101d is not in the specification. Applicants have amended FIG. 1 to include element 100. Applicants submit that element 101d is included in the specification on page 16, line 3. The Office Action objected to FIG. 3 because element 52, “PORTAL INTERFACE,” should be labeled element 352. Applicants have amended FIG. 3 by changing element 52 to element 352. The Office Action objected to FIG. 4 because element 490, which is discussed in the specification, is not shown in the drawing. The reference to element 490 in the specification is a typographical error and should instead refer to element 400, which is shown in FIG. 4. Accordingly, the specification has been amended to change the reference from element 490 to element 400. The Office Action objected to FIG. 30a, indicating that elements 3016 and 3018 are missing in the

specification. Applicants believe that the Office Action meant FIG. 30b instead of FIG. 30a because elements 3016 and 3018 do not appear in FIG. 30a but do appear in FIG. 30b. Applicants submit that element 3018 is included in the specification at page 80, line 5. In addition, Applicants have amended the specification by clearly indicating elements 3012, 3014, and 3016 for FIG. 30b. Applicants submit that the foregoing remarks, amendments to the specification, and amendments to FIG. 1 and FIG. 3 overcome the objections.

Rejections based on 35 U.S.C. § 112

The Office Action rejected claim 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action indicated that the phrase “of such a nature” renders the claim indefinite. Applicants have amended claim 10 to replace the phrase “of such a nature to be added as a part” with the phrase “compatible with the product configuration.” Support for the amendment may be found in the specification at page 58, lines 6 to 7, for example.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

The requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.03. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make

the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". See MPEP § 2143. Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985)." *Id.* See also MPEP § 706.02(j) and § 2142.

B. Rejections based on Beelitz in view of Forth

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,182,275 to Beelitz et al. (the "Beelitz reference") in view of U.S. Patent No. 6,853,978 to Forth et al. (the "Forth reference"). As a *prima facie* case of obviousness has not been established, Applicants respectfully traverse this rejection, as hereinafter set forth.

Referring initially to claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established because there is no suggestion or motivation to modify the Beelitz reference with the Forth reference. Independent claim 1 is directed to a method in a computing environment for determining compatibility of parts in a selected product configuration. The method includes determining whether a new part is compatible with one or more existing parts of the product configuration; and if said new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and said new part.

The Examiner rejected independent claim 1 by attempting to modify the Beelitz reference with the Forth reference. The Beelitz reference is directed to a system and method for specifying a build-to-order computer system. *See* Beelitz, at Abstract; col. 2 lines 26-27. Based on an indication that a customer wishes to purchase a computer system, the system presents a list of options available for the computer system. *See id.* at col. 4, lines 40-45. After the customer selects one of the options, the system generates a second list of options that are compatible with the previous selection and presents the second list of options to the customer. *See id.* at col. 4, lines 51-58.

The Forth reference is directed to a system and method for specifying intelligent electronic devices (IEDs). *See* Forth, at Abstract; col. 2, lines 17-20. Using the system, a customer may specify the type and model of IED, any hardware options to be installed, and custom software to be loaded. *See id.* at Abstract; col. 2, lines 20-38. The system may validate customer choices and provide valid substitutions for invalid choices. *See id.* at col. 12, lines 45-59. The Forth reference indicates that a “choice may be invalid where the specified type or model of IED is no longer manufactured or otherwise available, the chosen optional hardware is incompatible with the specified type or model of IED, or the custom frameworks specified by the customer are outdated or incompatible with the specified hardware.” *Id.*

Applicants respectfully submit that there is no suggestion or motivation to modify the Beelitz reference with the Forth reference because the modification would render the invention in the Beelitz reference unsatisfactory for its intended purpose. “If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” MPEP § 2143.01. The intended

purpose of the system in the Beelitz reference is to prevent customers from making invalid selections by presenting only compatible options to customers. For example, the Beelitz reference states that “[p]resenting a user with a list of options that are compatible with a previous selected choice advantageously allows a user to select from only those items that are compatible with the previous choice.” Beelitz at col. 4, lines 59-62. The Office Action attempts to modify the Beelitz reference with the Forth reference to provide the claim 1 feature: “if said new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and said new part.” Such a modification would require the Beelitz reference to allow incompatible selections to be made. However, the system in the Beelitz reference intentionally prevents incompatible selections by presenting only compatible options. Accordingly, Applicants respectfully submit that the modification would render the system in the Beelitz reference unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to modify the Beelitz reference with the Forth reference.

Similarly, Applicants respectfully submit that there is no suggestion or motivation to modify the Beelitz reference with the Forth reference because the modification would change the principle of operation of the system in the Beelitz reference. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” MPEP § 2143.01. The principle of operation of the system in the Beelitz reference is to present only compatible options based on a previous selection to prevent a user from make an incompatible selection. To modify the Beelitz reference with the Forth reference would destroy the principle of operation of the Beelitz system because incompatible options would have to be presented to allow for a new part

that was selected to be incompatible with an existing part. Accordingly, Applicants respectfully submit that the modification would change the principle of operation of the system in the Beelitz reference, and thus there is no suggestion or motivation to modify the Beelitz reference with the Forth reference.

Even if there was a suggestion or motivation to modify the Beelitz reference with the Forth reference, Applicants respectfully submit that a *prima facie* case of obviousness has not been established because the combination of the Beelitz and Forth references fails to teach or suggest all the claim limitations for independent claim 1.

The Office Action indicated that the Beelitz reference discusses “determining whether a new part is compatible with one or more existing parts of the product configuration.” *See* Office Action, p. 4-5. However, Applicants respectfully submit that the Beelitz reference fails to teach or suggest this limitation of independent claim 1. As indicated in the specification of the present application, a new part is one that is selected to either be added to a product configuration or replace an existing part in the product configuration. *See, e.g.*, Specification, at p. 56, line 11 through p. 57, line 17. In contrast, the Beelitz reference discusses generating a list of options that are compatible with a previous selection. The Beelitz reference is merely providing a list of compatible options. It does not discuss determining whether a particular new part that has been selected as an additional or replacement part of a product configuration is compatible with existing parts of the product configuration. Accordingly, Applicants respectfully submit that the Beelitz reference fails to teach or suggest “determining whether a new part is compatible with one or more existing parts of the product configuration,” as recited by independent claim 1.

The Office Action stated that the Beelitz reference failed to discuss “if said new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and said new part.” *See* Office Action, p. 5. Instead, the Office Action relies on the Forth reference for this limitation. Applicants respectfully submit that the Forth reference fails to teach or suggest this limitation as well. For this limitation, the Office Action refers to column 12, lines 45-49 of the Forth reference, which discusses providing a valid substitution for an invalid choice. In other words, the Forth reference discusses providing a substitution for only the chosen part (i.e. new part) that is incompatible. However, it does not discuss providing a substitution for the existing part that is incompatible with the chosen part. Thus, the Forth reference also fails to teach or suggest determining a replacement part for one of an existing incompatible part and a new part, as recited in independent claim 1.

Accordingly, Applicants respectfully submit that there is no suggestion or motivation to combine the Beelitz reference with the Forth reference and that the references, either alone or in combination, fail to teach or suggest all of the limitations of independent claim 1. For at least these reasons, a *prima facie* case of obviousness cannot be established for this claim based upon these references. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 1 is respectfully requested.

Each of independent claims 9 and 14 has features similar to those of independent claim 1, and the Office Action rejected the claims by modifying the Beelitz reference with the Forth reference similar to the rejection of claim 1. Accordingly, independent claims 9 and 14 are in condition for allowance for at least the above-cited reasons for independent claim 1. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of these claims as well.

Each of claims 2-8 depends, either directly or indirectly, from independent claim

1. In addition, each of claims 10-12 depends, either directly or indirectly from independent claim 9. Further, each of claims 15-20 depends, either directly or indirectly from independent claim 14. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness based upon the Beelitz and Forth references, either alone or in combination, cannot be established for these claims for at least the same reasons as cited above. “‘If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.’ *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP § 2143.03. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 2-8, 10-12, and 15-20 is respectfully requested as well.

Furthermore, many of the dependent claims are separately patentable because they contain additional limitations not taught or suggested by either the Beelitz reference or the Forth reference. For example, dependent claim 2 recites “replacing said existing incompatible part with a compatible alternative existing part.” For this limitation, the Office Action cites the Forth reference (col. 14, lines 40-47), which discusses providing a substitution for an invalid configuration (e.g., if a older model of an IED is no longer available). However, this cited portion of the Forth reference does not even discuss incompatibility. In addition, nothing in the Forth reference discusses replacing an existing incompatible part (i.e. an existing part of a product configuration that was determined to be incompatible with a new part) as recited by dependent claim 2.

Referring now to independent claim 13, Applicants respectfully submit that a *prima facie* case of obviousness has not been established because there is no suggestion or motivation to modify the Beelitz reference with the Forth reference and the references, either

alone or in combination, fail to teach or suggest all of the claim limitations. Claim 13 is directed to a computer readable medium containing a data structure for storing part incompatibility information, where in the data structure comprises a plurality of records in a table, each record include at least two product identification values, said values representing that said products represented by said identification values are incompatible, and an indication as to product identification values which are suitable replacements for at least one of said product identification values entered in said record.

Similar to the remarks for independent claim 1, Applicant's respectfully submit that the Office Action's proposed modification of the Beelitz reference with the Forth reference for independent claim 13 would render the Beelitz invention unsatisfactory for its intended purpose and would also change the principle of operation of the Beelitz invention. In FIG. 8A, the Beelitz reference illustrates a database that has part numbers and a corresponding compatibility tag for each part number. The compatibility tag indicates an option that is compatible with each part number. The Beelitz reference discusses accessing the database after receiving an option selection to generate a list of options that are compatible with the selected option, such that invalid selections are prevented. The Office Action attempts to modify the Beelitz reference with the Forth reference such that the database would indicate incompatibility and would provide an indication of replacements for the incompatibility. However, such a modification would render the Beelitz reference unsatisfactory for its intended purpose. The intended purpose of the database in the Beelitz reference is to provide compatibility information such that a list of compatible options may be generated based on a previous selection. The proposed modification would provide a database showing incompatibility and would not be able to fulfill this intended purpose. In addition, the modification would change the principle of

operation of the Beelitz reference such that the database provides incompatibility information and replacements for incompatible selections instead of providing compatibility information. Accordingly, Applicants respectfully submit that there is no suggestion or motivation to modify the Beelitz reference with the Forth reference.

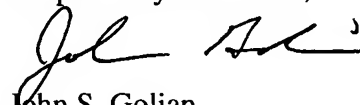
Even if there was a suggestion or motivation to modify the Beelitz reference with the Forth reference, Applicants respectfully submit that the Beelitz and Forth references, alone or in combination, fail to teach all of the limitations of independent claim 13. In particular, the Office Action states that Beelitz failed to disclose a record including “an indication as to product identification values which are suitable replacements for at least one of said product identification values entered in said record.” Instead, the Office Action relies on the Forth reference for this limitation. The Forth reference merely discusses providing a valid substitution for an invalid choice. It does not discuss a record in a table that includes an indication as to product identification values which are suitable replacements for at least one of said product identification values entered in said record. Thus, Applicants respectfully submit that the Beelitz and Forth references, either alone or in combination, fail to teach or suggest each of the limitations of independent claim 13.

Accordingly, Applicants respectfully submit that there is no suggestion or motivation to modify the Beelitz reference with the Forth reference and that the references, either alone or in combination, fail to teach or suggest all of the limitations of independent claim 13. For at least these reasons, a *prima facie* case of obviousness cannot be established for this claim based upon these references. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 13 is respectfully requested.

CONCLUSION

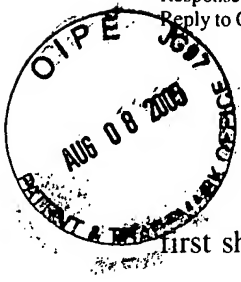
For at least the reasons stated above, claims 1-20 are now in condition for allowance. Applicant respectfully requests withdrawal of the pending rejections and allowance of claims 1-20. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 21-0765.

Respectfully submitted,



John S. Golian
Reg. No. 54,702

SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550



AMENDMENTS TO THE DRAWINGS

The two attached sheets of drawings include changes to FIG. 1 and FIG. 3. The first sheet, which includes FIG. 1, replaces the original sheet including FIG. 1. In FIG. 1, the label indicating element 100 has been included. The second sheet, which includes FIG. 3, replaces the original sheet including FIG. 3. In FIG. 3, element 52, "PORT INTERFACE," has been relabeled as element 352.

Attachment: Replacement Sheets